

REMARKS

This application has been reviewed in light of the Office Action dated February 8, 2007. Claims 1-23 are pending in the application. Claims 1-23 are amended in a manner that Applicant believes overcome the rejections in the Office Action. Support for the amendments can be found throughout the specification and figures of the present disclosure and recite aspects of the disclosure to which Applicant is believed to be entitled. Applicant submits that no new matter or issues are introduced by the amendments.

Generally, the inventive system and method differ fundamentally from the cited prior art. The present inventive system delivers a multimedia product, and downstream marketing and advertising to purchasers. This dual marketing feature can be used, for example, to transmit a movie as well as advertising material for marketing the movie. Therefore, the present inventive system and method benefit from several advantages such as the capability to download movies and associated advertising to increase patron attendance, market locally, and create a customer database.

In this amendment, the Applicant has attempted to precisely claim the invention, seeking only to protect the patentable aspects of its contribution to the art. Applicant did not invent and the pending claims to not control the downloading of audiovisual material. Certainly, the claims allow competitors to continue to perform the various operations taught by the prior art in the manner of the prior art. Applicant merely seeks to protect its contribution to the technology. Moreover, the allowance of the subject claims to Applicant's invention helps make Applicant a more viable competitor by protecting the fruits of its investment in technology and, thus, encourages competition stimulates development of more attractive or alternative technologies. Likewise, to the extent that different parties have attractive contributions to make to the technology, crosslicensing is encouraged, as is further investment in the technology by other competitors to enable them to participate in such corroborative activities.

Indeed, Applicant and Examiner agree respecting novelty, the first requirement for patentability. The existence of novelty, guarantees that the pending claims will not affect the freedom of others to practice prior art, for example, by the continuing availability of separate transmission to others. A unitary system such as the proposed invention which has the capability

of sending different advertising to different locations allows for the integration of different advertisements and provides the ability to analyze effectiveness for future marketing.

As far as obvious this is concerned, then existing technology had the ability to implement all but video transport aspect of the invention since, perhaps, 1990. Nevertheless, for over a dozen years, the prior art failed to create the highly advantageous system of Applicant's invention. Certainly, if the claimed invention were obvious, and a complete conception would have entered the prior art, particularly given the number of individuals working in the information technology sector and the intense competition to stake out various business franchises in this field.

Turning to the specifics of the instant Office Action, Claims 1, 2, 5-9, 11-13, 15-20, and 23 were rejected under 35 U.S.C. § 103(a) over U.S. Patent Publication No. 2002/0162113 to Hunter ("Hunter") in view of Applicant's originally filed specification and U.S. Patent No. 5,918,213 to Bernard et al. ("Bernard"). However, it is respectfully submitted that amended independent claims 1, 11, 12 and 23 and claims that ultimately depending therefrom clearly and patentably distinguish over the Hunter publication in any combination with Applicant's originally filed application and the Bernard patent.

The Hunter publication discloses a system 20 for placement of advertisement displays 30 located in high vehicular and pedestrian traffic areas (paragraph 0021), and in a separate embodiment, a system 220 that connects movie display devices 230 located in movie theater (0059). In an alternate embodiment, a system 420 has an input module 470 that transmits advertising displays 30 and separately transmits movies to movie theater display devices 30M disposed in an alternate location (0070). The Hunter publication does not disclose any content association between advertisement display 30 and the movies displayed from devices 30M. Claim 1 of Applicant's claimed invention requires that the advertising material be content associated with the multimedia material and that the advertising be linked to the multimedia material.

Similarly, Hunter does not disclose receiving advertising from the owner of the multimedia or film or storing the advertising in digital format. Hunter also fails to disclose the

step of inputting multimedia information capable of being searched. Furthermore, Hunter does not disclose providing a search function for said multimedia material and said associated advertising material as required by claim 1 of Applicant's claimed invention.

The Examiner states that Applicant's own specification states that it is conventional for owners of multimedia material to provide advertising material to purchasers to locally market and sell said multimedia material (office action, page 3-4). Applicant respectfully disagrees with Examiner's characterization of Applicants specification. Applicant's specification states that material "that are normally transported physically from the owner, such as the producer or other owner of rights, to the person licensing the movie, are digitized and stored in storage media 28 in accordance with the invention." Applicant's specification thus clearly only states that materials are merely physically transported in the prior art.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580, 582 (CCPA 1974); see also *CFMT Inc. v. Yieldup International Corp.*, 68 USPQ2d 1940, 1947 (Fed. Cir. 2003) and *Leinoff v. Louis Milona & Sons, Inc.*, 220 USPQ 845 (Fed. Cir. 1984). As indicated in the Office Action "the Hunter reference does not specifically disclose

The Examiner also discusses Bernard, which discloses an automated product purchasing and receiving system (col. 9, lines 58-62), whereby an order is placed and a fulfillment vendor 436 then processes and ships the order by mail (col. 24, lines 13-29). Bernard does not relate to purchasing multimedia for download over a communications network such as the Internet.

Bernard does not cure the deficiencies of Hunter. Like Hunter, Bernard fails to disclose any content association between advertisement display 30 and the movies displayed from devices 30M, receiving advertising from the owner of the multimedia or film, storing the advertising in digital format, inputting multimedia information capable of being searched or providing a search function for said multimedia material and said associated advertising material as required by Applicant's claimed invention. Claims 2 and claims 5-9 depend from claim 1 and for the same reasons as stated above are not made obvious by Hunter in view of Applicants own specification or Bernard.

Claim 11 requires an input device connected for data transfer to said first central processing unit, said input device receiving multimedia material and associated advertising material. Neither Hunter nor Bernard disclose an input device that receives multimedia material and associated advertising material. Hunter discloses multimedia or advertising but not receiving both or that the advertising material is associated with the multimedia.

Referring to claims 12, 13 and 15-20, as previously discussed with respect to claim 1, neither Hunter nor Bernard disclose receiving multimedia material from a producer or owner of said multimedia material, storing advertising material associated with said multimedia material or providing said multimedia material that is linked to said advertising material (emphasis added). Claim 13 and claims 15-20 depend from claim 12 and for the same reasons are not obviated by Hunter in view of Bernard.

Claim 23 of Applicant's claimed invention requires multimedia and content associated advertising. Neither Hunter nor Bernard disclose content associated advertising.

Because of the above distinctions and advantages of the present disclosure, it is respectfully submitted that amended independent claims 1, 11, 12 and 23 and the claims ultimately depending therefrom are patentable and not obvious over Hunter in any combination with Applicant's originally filed application and Bernard. Reconsideration and withdrawal of the rejections are respectfully requested.

In the Office Action, claims 3, 4, 10, and 14 are rejected under 35 U.S.C. § 103(a) over Hunter in view of Applicant's originally filed specification and Bernard as applied to claims 1 and 12, in further view of U.S. Patent No. 5,564,043 to Siefert ("Siefert"). As previously discussed with respect to claim 1, Hunter, Applicant's specification and Bernard fail to disclose any content association between advertisement display 30 and the movies displayed from devices 30M, receiving advertising from the owner of the multimedia or film, storing the advertising in digital format, inputting multimedia information capable of being searched or providing a search function for said multimedia material and said associated advertising material as required by Applicant's claimed invention.

Furthermore, as stated by the Examiner, claims 3, 4, 10 and 14 fail to disclose the receiving multimedia material includes receiving non-digital celluloid media and printed media.

The Examiner discusses Seifert which discloses a system for managing resources, which can take the form of computer-compatible information, such as data files and programs, and non-computer-compatible information, such as data contained on microfiche, and physical objects (abstract). Seifert is directed to managing resources not to purchasing multimedia for download over a communications network such as the Internet.

Referring to claim 10, as currently amended claim 10 requires receiving a movie on celluloid and associated advertising material together from the movie owner; scanning the movie and converting it into a digital format, storing said movie in digital format and said associated advertising material in digital format in a computer readable memory, such that said advertising material and said movie are linked and inputting licensing information about the movie (emphasis added). Hunter merely discloses movie producers making content available via satellite transmission system [0063] and fails to disclose receiving a movie on celluloid and associated advertising material, scanning the movie and associated advertising material such the advertising material and movie are linked. Furthermore, Hunter fails to disclose inputting licensing information about the movie. Neither Bernard, Siefert nor Applicant's originally filed specification cure these deficiencies.

Claims 3 and 4 depend from claim 1 and claim 14 depends from claim 12. For the reasons stated above no combination of Hunter, Bernard, Applicant's own invention or Seifert make obvious Applicant's claimed invention. Reconsideration and withdrawal of the rejections are respectfully requested.

In view of the foregoing amendments and remarks, it is respectfully submitted that claims 1-23 presently pending in the application are in condition for allowance and patentably distinguish over the art of record. An early notice thereof is earnestly solicited.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call the Applicant's undersigned attorney.

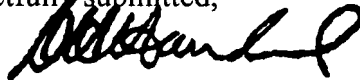
Please charge any deficiency as well as any other fee(s) which may become due at any time during the pendency of this application, or credit any overpayment of such fee(s) to ***Deposit Account No. 50-0369***. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge ***Deposit Account No. 50-0369*** therefor.

Dated: _____

8/8/07

Respectfully submitted,

By: _____



Anthony H. Handal, Esq.

Reg. No. 26,275

Attorney for Applicant

Customer No. 21710

Brown Rudnick Berlack Israels LLP

One Financial Center

Boston, MA 02111

Tel: 212.209.4942

Fax: 617-856-8201